

Atty. Dkt. No. 035451-0120 (3600.Palm)

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Claims 69 are now pending in this application.

Claim Rejections – 35 U.S.C. §103

In section 2 of the Office Action the Examiner rejected claims 1-3, 6-9, 11-12, 14-15, 18-20, 24-26, 29-32, 34-35, 37-38, 41-43, 47-49, 52-55, 57-58, 60, 63-65, and 69 under 35 U.S.C. §103(a) as being unpatentable over Mills et al. (U.S. Patent No. 6,353,870 in view of SDA.

Applicants have reviewed the Mills et al. reference and respectfully submit that independent claims 1, 24, and 47 are distinguishable over the Mills et al. reference in view of SDA. Although SD, SDIO, and MMC slots and cards were well known at the time of the invention, it was not contemplated to have an SDIO interface on an expansion module that interfaces with an SD slot on a handheld computer, with the expansion module also having an SD slot of its own. What is taught by Mills et al. is that a module that fits in a first sized slot (such as a compact flash slot) has a slot of its own to accommodate an SD sized memory card. Mills et al. discloses a smaller slot in the module to accommodate an SD sized card. However, Applicants invention could not be embodied in the structure disclosed in Mills et al. because the module in Mills et al. fits within the larger slot of the handheld computer and then has a smaller slot in the module for accepting the SD card. Applicants claimed invention necessitates a different structure such as the piggyback structure (see FIG. 3) where the SD card slot is outside of the housing of the handheld computer, but parallel to the back of the handheld computer. Mills et al. in combination with SDA does not disclose, teach or suggest all of the claim

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limitations of Applicants invention, nor does it provide any motivation to combine the two references to arrive at Applicants invention. The use of a slot in the module for a memory card that is the same size as the slot in the handheld computer is not disclosed by any proper combination of the references. Such a design provides very different advantages to the advantages of Mills et al. configuration in which the two slots are of different size. Applicants invention makes it easy for a user of the handheld computer to have access to an SD-sized memory card whether they are carrying the module or not, whereas Mills et al. cannot access an SD-sized memory card unless the module is in the larger slot in the handheld computer.

For all of the reasons provided above, Applicants respectfully submit that independent claims 1, 24, and 47 and their respective dependent claims (constituting all of the claims in the application) are allowable.

In Sections 3-9 of the Office Action the Examiner rejected various dependent claims under 35 U.S.C. §103 with the primary references being the combination of Mills et al. and SDA. Applicants respectfully submit that the dependent claims rejected in these sections of the Office Action are allowable for the same reasons as provided above with regard to the independent claims 1, 24, and 47.

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Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even

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entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date

May 23, 2005

By

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